

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JONATHAN SCOTT HIRSHBERG

Appeal No. 2004-0061
Application 09/745,762

ON BRIEF

Before FRANKFORT, STAAB, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 23 through 35, all of the claims remaining in this application. Claims 1 through 22 have been canceled.

Appellant's invention relates to a bag for carrying articles and, more particularly, to a bag used to carry sports items such as sports clothing, athletic shoes, and related items used during an athletic event. On page 3 of the specification, appellant summarizes the invention as follows:

[t]he present invention is a sports bag which is defined to include any carrying bag such as a duffel bag, backpack, gym bag or other bag which is used to carry articles such as sports equipment, a thermos, sports clothing, etc., which includes a mat which is conveniently stored inside the sports bag when not in use and can be removed through an opening in the sports bag to permit the mat to be extended transverse to the sports bag so that it provides a flat surface on which the user may rest or place articles. The rollout mat can be permanently affixed to the sports bag or it can be removably affixed and attached by means of fasteners such as male and female mating hook and loop fasteners, snaps, etc.

On page 7 of the specification, appellant more particularly notes that a preferred option of the invention is to house the rollout mat (40) seen in Figures 1, 2 and 4 of the application drawings within a separate interior compartment (50) within the interior (14) of the sports bag (10) so that the rollout mat is segregated from the rest of the interior of the sports bag. One possible segregating means (52) is illustrated in Figure 4 and comprises a flexible wall sewn into portions of the interior surface (8) of the sports bag (10) to create the interior

compartment (50) within which the rollout mat (40) is housed. Access to the interior compartment (50) and the rollout mat therein is provided by a separate opening (6) in a wall of the bag which is created by opening means (36), which may be a zipper.

Independent claims 23 and 29 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief (Paper No. 7).

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims¹ is:

Shreim	2 061 712	May 20, 1981
(Published UK Patent Application)		

¹ While the examiner has also listed U.S. Patent No. 4,154,323 to Sneider, on page 3 of the answer, as being "relied upon in the rejection of claims under appeal," we note that such patent is not included in the statement of any rejection on appeal, or pointed to in the body of any such rejection. The answer itself, on page 7, expressly notes that the Sneider patent is "used for a cited reference but not for prior art in the rejection." Thus, we will not look to the Sneider patent in our deliberations in this appeal. In that regard, as pointed out by the Court in In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970), where a reference is relied upon to support a rejection, whether or not in a minor capacity, there would appear to be no excuse for not positively including the reference in the statement of the rejection.

Claims 23 through 35 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim that which appellant regards as the invention. In the examiner's view, the claims on appeal are indefinite because it is unclear in independent claims 23 and 29 how the second interior compartment can be retained within the first large interior compartment "while the second compartment be sharing a portion of the interior surface of the large compartment and divided by a dividing wall" (answer, page 4).

Claims 23 through 35 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shreim.

Rather than reiterate the examiner's full commentary regarding the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the examiner's answer (Paper No. 8, mailed January 13, 2003) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 7, filed October 24, 2002) and reply brief (Paper No. 9, filed March 12, 2003) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art Shreim reference, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

We turn first to the examiner's rejection of the appealed claims under 35 U.S.C. § 112, second paragraph. After reviewing appellant's specification, drawing Figures 1 through 4, and the claims on appeal in light thereof, and also in light of appellant's arguments in their brief (pages 11-12) and reply brief, it is our opinion that the scope and content of the subject matter embraced by appellant's claims on appeal are reasonably clear and definite, and fulfill the requirements of 35 U.S.C. § 112, second paragraph. In our view, the examiner's criticism of the language used in appellant's claims on appeal is misplaced. In determining whether a claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity, the definiteness of the language

employed in the claim(s) must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. See In re Johnson, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977). When that standard of evaluation is applied to the language employed in the claims before us on appeal, we are of the opinion that those claims set out and circumscribe a particular area with a reasonable degree of precision and particularity.

Given the foregoing, we will not sustain the examiner's rejection of appellant's claims 23 through 35 under 35 U.S.C. § 112, second paragraph.

We next look to the examiner's prior art rejection of claims 23 through 35 under § 103(a) as being unpatentable over Shreim. After a careful assessment of appellants' independent claims 23 and 29 and of the Shreim reference, we must agree with appellant's position as set forth in the brief (pages 12-16) and in the reply brief, that Shreim does not disclose a second interior compartment carved out of and retained within a first

large interior compartment of the bag (2) therein and divided therefrom by an interior dividing wall, with the second interior compartment sharing a portion of the interior surface of the first large interior compartment and having a second opening in the exterior surface of the bag leading only to said second interior compartment, whereby the mat may be rolled into said second interior compartment and retained therein and segregated from the remainder of the first large interior compartment.

Shreim describes the flap (14) therein as being "attached to the lower edge of the side 16 of the bag" (page 1, lines 75-84) and the sheets (20, 22), in a storage position, as laying against "the side of the bag" (page 1, lines 30-32). Thus, it is clear to us that the compartment defined between the side (16) of the bag in Shreim and the flap (14) attached thereto for storing the sheets (20, 22) would have been viewed by one of ordinary skill in the art as being an exterior compartment added on to an exterior surface of the bag, and clearly distinguishable from appellant's "second interior compartment" carved out of and

retained within a first large interior compartment of the bag and divided therefrom by an interior dividing wall which segregates the second compartment from the remainder of the first large interior compartment.

As for the examiner's further position that the detachable absorbent sheet (22) in Shreim, identified by the examiner as corresponding to the rollable mat of appellant's claims on appeal, can be formed of the same PVC material as the exterior of the bag "since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice," and the position that it would have been obvious to one having ordinary skill in the art to make sheet/mat (22) of Shreim "being permanently affixed as claimed, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art," we find such positions to be untenable and entirely contrary to the clear teachings in the Shreim reference (page 1, lines 97-110) concerning the detachable, absorbent fabric sheet (22). In our

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opinion, the examiner's positions here represent a classic case of hindsight reconstruction after having viewed appellant's disclosure and claims.

In light of the foregoing, we must refuse to sustain the examiner's rejection of claims 23 through 35 under § 103(a) as being unpatentable over Shreim.

To summarize our decision, we note that 1) the examiner's rejection of claims 23 through 35 under 35 U.S.C. § 112, second paragraph, has not been sustained, and 2) the examiner's rejection of claims 23 through 35 under § 103(a) as being

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unpatentable over Shreim has not been sustained. Thus, the decision of the examiner rejecting claims 23 through 35 of the present application is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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JENNIFER D. BAHR)	
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